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Claims 1-36 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Nakagawa et al, (United States Patent 5,819,295, hereinafter "Nakagawa") and in view of Trede et al, (United States Patent 5,873,103, hereinafter "Trede").

The present invention provides for a structured WorkFolder for organizing electronic documents in a self-contained data repository. The WorkFolder comprises sections for grouping related documents, and space-reserving placeholders for indicating documents expected to be placed in the WorkFolder.

In the present invention, a Placeholder 24 is defined as a slot that has been reserved for one or more specific documents not yet created or received. When the WorkFolder is used to organize documents for a given work item, the presence of the Placeholder 24 within the WorkFolder indicates to the user that specific documents are expected to be created and stored there. (See Specification page 7, lines 4-12 and Figs. 1-2).

As now presented, Base Claim 1 of the present invention recites "...space-reserving placeholders within said work folder, the placeholder being for new documents expected to be added to said workfolder via said placeholder."

To establish a prima facie case of obviousness 1) all claim limitations must be taught or suggested; 2) some teaching, motivation or suggestion to combine must be present in a person of ordinary skill in the art or in cited references; and 3) there must be a reasonable expectation of success.¹ The Office Action at hand states that Nakagawa does not teach "space-reserving placeholders or a contents node." The Office Action further states that Trede teaches "space-reserving placeholders and a contents node." The Office Action further states "it would have been obvious to one having ordinary skill in the art at the time the invention was made to use space-reserving placeholders and to have a contents node by incorporating the teachings of Nakagawa in Trede because this facilitates the use of holding a place in a hierarchical file system of folders for managing electronic documents when old versions of documents are stored or moved." Applicants respond accordingly.

The Office Action observes Nakagawa does not teach, "space-reserving placeholders" or a "contents node." The term "placeholder" in Trede has a different meaning than the term "placeholder" in the present invention. In Trede, the term "placeholder" denotes a data file, whereas in the present invention the term "placeholder" denotes a slot or reserved space. (Col. 2, lines 11-12, Trede). The Trede placeholder entry (data file) is written when an existing file is

¹ In re Vack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

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moved from one place to another. In Trede, the placeholder entry (data file) contains "migration information" about the moved file. The placeholder entry (data file) allows the user to locate the moved file using the migration information stored in the placeholder entry (data file). (Col. 4, lines 33-47, Trede).

Further, Trede's data management system provides the capability to move and/or copy the placeholder files (data files) from one file server volume to another file server volume, even if the destination file server volume resides on a different file server. The moving and/or copying of placeholder files (data files) allows continued tracking and user access of files having migration information stored in the placeholders (data files). The moving and/or copying of placeholder files (data files) teaches away from the present invention's creating and storing new documents within a slot (space) of the WorkFolder reserved by a placeholder. (Col. 12, lines 32-39, Trede). Restated, the data file system of Trede could be used with the present invention. In that instance, when a structured WorkFolder of the present invention is moved from one memory location to another, the Trede system writes corresponding migration information in a data file entry (Trede's placeholder). Using the migration information written in the Trede style data files, an end user is able to locate the invention WorkFolder and its contents (i.e., existing documents and/or the invention space-reserving placeholders which indicate future expected documents). If various such WorkFolders resided on multiple file servers, the Trede data files would be moved and/or copied onto the different file servers to provide migration information across the file servers. Throughout the foregoing, the invention placeholders within a given WorkFolder are treated synonymously to existing documents for the purposes of the Trede data file system and migration information therein. Thus, when a new document is placed in a placeholder (of Applicants' invention) of a WorkFolder, the migration information of Trede's system continues to track location of the WorkFolder. As such, nothing of the Trede system provides for, serves as, teaches, implies or suggests the space-reserving placeholders of the present invention.

Since all the limitations of Base Claim 1, including "...space-reserving placeholders within said workfolder, the placeholder being for new documents expected to be added to said workfolder via said placeholder," are not taught, suggested or otherwise made obvious by cited art (Nakagawa and Trede), now Base Claim 1 is believed to be patently distinguishable over the cited art. Therefore, it would have not been obvious to one of ordinary skill in the art at the time the invention was made to modify Nakagawa with the teachings of Trede to form the invention of

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Base Claim 1. Therefore, Applicants respectfully request withdrawal of the rejection of Base Claim 1 under 35 U.S.C. 103(a)

The above remarks regarding Base Claim 1 also apply to dependent claims 2-27 by virtue of the fact, that if an independent claim is unobvious under 35 U.S.C. 103, then any claim depending therefrom is unobvious. Therefore, Applicant's respectfully request the withdrawal of the rejection of claims 2-27 under 35 U.S.C. 103(a).

Base Claim 28 of the present invention recites "...a space-reserving placeholder within said workfolder, the placeholder being for new documents expected to be linked to said workfolder..."

With respect to claims 28-31, the Office Action states "these claims have been rejected for similar rationale given for claims 1, 2, 18, and 22. Applicants respond accordingly.

As discussed above, neither Nakagawa or Trede imply, suggest or otherwise make obvious "a space-reserving placeholder within said workfolder, the placeholder being for new documents expected to be linked to said workfolder" as in the present invention of Base Claim 28. Rather, as discussed above, Trede's placeholder denotes existing data files for holding migration information and not a slot (space) as in the present invention. Further, Trede's moving and/or copying of placeholder files (existing data files) teaches away from the present invention's creating and storing new documents within a slot (space) of the WorkFolder reserved by a placeholder.

Since all the limitations of Base Claim 28, including "a space-reserving placeholder within said workfolder, the placeholder being for new documents expected to be linked to said workfolder," are not taught, suggested or otherwise made obvious by cited art (Nakagawa and Trede), Base Claim 28 is believed to be patently distinguishable over the cited art. Therefore, it would have not been obvious to one of ordinary skill in the art at the time the invention was made to modify Nakagawa with the teachings of Trede to form the invention of Base Claim 28. Therefore, Applicants respectfully request withdrawal of the rejection of Base Claim 28 under 35 U.S.C. 103(a)

The above remarks regarding Base Claim 28 also apply to dependent claims 29-36 by virtue of the fact, that if an independent claim is unobvious under 35 U.S.C. 103, then any claim depending therefrom is unobvious. Therefore, Applicant's respectfully request the withdrawal of the rejection of claims 29-36 under 35 U.S.C. 103(a).

Claim 37 has been rejected under 35 U.S.C. 103 (a) as being unpatentable over Trede.

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Base Claim 37 of the present invention recites "...creating at least one space-reserving placeholder within said workfolder, the placeholder being for new documents which may or may not exist at the time of workfolder creation and are expected to be linked to said workfolder via said placeholder."

As discussed above, Trede does not imply, suggest or otherwise make obvious "creating at least one space-reserving placeholder within said workfolder, the placeholder being for new documents which may or may not exist at the time of workfolder creation and are expected to be linked to said workfolder via said placeholder" as in the present invention of Base Claim 37. Rather, as discussed above, Trede's placeholder denotes existing data files for holding migration information and not a slot (space) as in the present invention. Further, Trede's moving and/or copying of placeholder files (data files) teaches away from the present invention's creating and storing new documents within a space of the WorkFolder reserved by a placeholder.

Since all the limitations of Base Claim 37, including "...creating at least one space-reserving placeholder within said workfolder, the placeholder being for new documents which may or may not exist at the time of workfolder creation and are expected to be linked to said workfolder via said placeholder," are not taught, suggested or otherwise made obvious by cited art (Trede), Base Claim 37 is believed to be patently distinguishable over the cited art. Therefore, Applicants respectfully request withdrawal of the rejection of Base Claim 37 under 35 U.S.C. 103(a).

Claims 38-58 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Trede in view of Nakagawa. The rejection is respectfully traversed.

Since Claims 38-58 are dependent on Base Claim 37, the above remarks regarding Base Claim 37 also apply to dependent claims 38-58 by virtue of the fact, that if an independent claim is unobvious under 35 U.S.C. 103, then any claim depending therefrom is unobvious. Therefore, Applicant's respectfully request the withdrawal of the rejection of claims 38-58 under 35 U.S.C. 103(a).

CONCLUSION

In view of the above amendments and remarks, it is believed that all pending claims (Claims 1-58) are in condition for allowance, and it is respectfully requested that the application

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be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (978) 341-0036.

Respectfully submitted,

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